



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,920	09/14/2000	Wilson Moya	MCA-474	9899
25182	7590	06/02/2004	EXAMINER	
MILLIPORE CORPORATION 290 CONCORD ROAD BILLERICA, MA 01821			VO, HAI	
		ART UNIT		PAPER NUMBER
		1771		

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

mu

Office Action Summary	Application No.	Applicant(s)
	09/661,920	MOYA, WILSON
	Examiner	Art Unit
	Hai Vo	1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,3,9 and 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2,3,9,11,12 and 14-26 is/are rejected.
- 7) Claim(s) 13 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

1. The examiner suggests that the claim will sound better if claim 21, line 2, the phrase "of a material" is preferably added before "selected from the group".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 2, 3, 9, 12, 14-16, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Pouletty et al (US 5,288,648) substantially as set forth in the 12/12/2003 Office Action. The art rejections have been maintained for the following reasons. As pointed out by Applicant, the areas of non-porous material are created in the porous membrane and the rest of the areas of the porous membrane remain porous. However, the language of claim 1 does not require the porous material and non-porous material formed from the same material. Similarly, nothing in claim 1 is specific about the depth of the porous area, therefore, the porosity of the filter below the tape still reads on the claimed subject matter. Accordingly, the art rejections are thus sustained.
4. Claims 2, 3, 9, 11, 12, 14-21, and 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Moya et al (US 5,271,839) substantially as set forth in the 12/12/2003 Office Action. Applicant argues that Moya forms the porous areas in a non-porous substrate, which is opposite to the presently claimed invention. However, there are no structural differences between the resulting products from the

two inventions. Moya discloses a patterned porous filtration structure comprising two porous patterned sheets 80 and 86 and a layer 92 of non-porous material being disposed between two porous patterned surfaces 80 and 86 (figure 14, column 3, lines 5-10). Figure 14 shows that one area of porous material surrounded by one area of non-porous material along an outer periphery of the porous material. The patterned porous filtration structure of the presently claimed invention does not exclude Moya. Applicant argues that the porous material is not in the form of ovals but circles instead. The circle shape of the porous material as disclosed in Moya reads on the claim limitation. Applicant argues that there is no porous membrane disclosed in the Moya reference. The examiner disagrees. Moya discloses a patterned porous polyamide product having two porous patterned surfaces and a non-porous layer within the interior of its thickness (example 1). Moya further discloses the porous portion of the product has ultrafiltration pores having a size about 40 angstroms to 0.05 micron (column 7, lines 52-56). Likewise, Moya discloses the porous polyamide membrane. Accordingly, the art rejections are thus sustained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moya et al (US 5,271,839) as applied to claim 2 above, in view of Wang et al (US 6,045,694). While it is true each limitation is considered, it appears that any porous membrane as defined in claim 2 having a surface modification reads on the claimed subject matter; therefore the limitations "before the formation of the porous and non-porous areas" and "after the formation of the porous and non-porous areas" do not further define the claimed product. They do not patentably distinguish the product claims because the final product would be the same. Moya does not specifically disclose the porous membrane having the surface to be coated with a hydrophilic coating. Wang, however, teaches the filtration membrane suitable for wetting and positive charge modification to improve the retention of anionic dye (abstract). This is important to the expectation of successfully practicing the invention of Moya and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to treat the surface of the porous membrane as disclosed in the Moya reference with a wetting agent, followed by the positive charge modification motivated by the desire to improve the retention of anionic substances, thereby increasing the filtration efficiency.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 2, 3, 9, 12, 14, 16, 25 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,627,291 substantially as set forth in the 12/12/2003 Office Action. The obviousness-type double patenting is sustained until the terminal disclaimer is received.
9. The claim objections have been withdrawn in view of the present amendment

Allowable Subject Matter

10. Claim 13 would be allowable if rewritten to overcome the objections above. None of the prior art teaches or suggests the patterned porous structure wherein the porous structure is formed of two or more layers and each of the layers have one or more areas of porous material and one or more areas of non-porous material formed therein and the areas of the porous and non-porous material vary from layer to layer.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV



Ms. Arti R. Singh
Primary Examiner
Tech Center 1700